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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,456	08/02/2001	Dwip N. Banerjee	AUS920010503US1	5605

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EXAMINER

VAN BRAMER, JOHN W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/920,456	Applicant(s) BANERJEE ET AL.	
	Examiner John Van Bramer	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 10-19, 21, 24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-19, 21, 24 and 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>100101</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on January 11, 2006 corrected the deficiencies in the Abstract and as such that objection is withdrawn. The amendment cancelled claims 22 and 23, which corrected the antecedent basis objections in the previous office actions.

Claims 1, 10 – 15, 19, 21, 24, and 26 – 29 have been amended. Claims 6 – 9, 20, 22, 23, and 25 have been cancelled and no new claims were added. Therefore, the currently pending claims considered below are: Claims 1 – 5, 10 – 19, 21, 24, and 26 – 30.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 28 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The mere incorporation of data on a disk is considered non-functional descriptive material (See MPEP 2106(IV)(B)1(b)). This objection is maintained because the amended claim does not correct the deficiency. The claim, as amended, does not specify that the invention is a product, on a computer readable medium that is executable to perform the stated steps. The examiner suggests changing the preamble to read "A programmed product, stored on a computer readable medium, containing program code that is executable to

provide program signals being selectively operable for:" in order to overcome the claim deficiencies.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 24, 26, 27 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki (U.S. Patent Number 6,129,274).

Claim 24: Suzuki discloses a computer terminal in a store environment wherein products are offered to customers, said computer terminal comprising:

- a. Input means by which said customers are enabled to input product information, said product information being sufficient to identify a particular product. (Col 8, lines 59-65 and Col 6, lines 15-21)
- b. Means for displaying discount information related to said particular product, said discount information containing a plurality of discounts available from one or more different entities, said input means being selectively operable by

a customer to choose one selected discount from said plurality of displayed discounts. (Col 7, lines 7 – 57)

- c. Means for saving said one selected discount in memory. (Col 7, line 58 through Col 8, line 29)
- d. Means for transmitting said one selected discount to a check-out terminal when said customer has requested check-out. (Col 7, line 58 through Col 8, line 29)

Claim 26: Suzuki discloses a computer terminal as set forth in claim 24 wherein said means for transmitting is further selectively operable to transmit said one selected discount to a local server system. (Col 9, lines 8-17)

Claim 27: Suzuki discloses a computer terminal as set forth in claim 26 wherein said one selected discount is stored at said local server system. (Col 9, lines 8-17)

Claim 29: Suzuki discloses a computer system arranged for processing discounts to a customer for products being offered to said customer, said computer system comprising:

- a. Means for storing a searchable product discount database. (Col 13, lines 6-9)
- b. Means for receiving information identifying a particular product by a customer. (Col 8, lines 62-65);
- c. Means for searching said product discount database to determine discount information applicable to said particular product, said discount information

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- including a plurality of different discounts available from one or more different entities. (Col 13, lines 6-9)
- d. Means for transmitting said discount information for display on a customer device by which said customer may select a preferred discount from said plurality of different discounts. (Col 13, lines 51-56 & lines 59-62)
- e. Means for receiving information identifying said preferred discount from said customer device. (Col 12, lines 4-7)
- f. Means responsive to a request received from a checkout terminal for transmitting said preferred discount information to said checkout terminal.(Col 7 lines 62-67 and Col 8 lines 1-4)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5 and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent Number 6,129,274).

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Claim 1: Suzuki discloses a method for processing discounts to a customer for products being offered to said customer, said method comprising:

- a. Entering product information into a customer processing device, said product information being sufficient to identify a selected product. (Col 8, lines 59-65)
- b. Transmitting said product information from said customer processing device to a server, said server being responsive to a receipt of said product information for determining discount information, said discount information being related to a plurality of different discounts available from one or more different entities for said selected product. (Col 9, lines 8-13 and Col 6, lines 15-30 and Col 7, lines 36 – 57)
- c. Transmitting said discount information from said server to said customer processing device. (Col 9, lines 13-17)
- d. Displaying said discount information on a display screen of said customer processing device. (Col 8, lines 65-67 and Col 9, lines 1-4)
- e. Using said customer processing device to choose a selected discount from said plurality of different discounts. (Col 7, lines 7 – 57)
- f. Saving said selected discount in a memory. (Col 11, lines 42-49)
- g. Determining when said customer request to pay for said selected product. (Col 7, line 58 through Col 8, line 14)

- h. Determining said selected discount from memory upon said determining. (Col 7, line 58 through Col 8, line 14)
- i. While Suzuki is silent with regard to charging an appropriate account for each selected discount chosen by said customer, said charge being made after said customer has paid for said selected product. It is obvious that redeemed discounts must be accounted for in some fashion. This accounting usually includes either write-offs or manufacturer reimbursements. Suzuki discloses both a loyalty incentive account and a senior citizen discount account that can be used for discount processing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ability to charge appropriate accounts after the discount has been chosen and the product paid for. One would have been motivated to do this in order to allow the retail store to properly account for the discounts it provides. (Col 7, lines 7 – 35)

Claim 2: Suzuki discloses a method as set forth in claim 1 wherein said product information is entered into said customer processing device manually by said customer. (Col 8 line 67 and Col 9 line 1)

Claim 3: Suzuki discloses a method as set forth in claim 2 where said product information is entered by said customer at a discount kiosk station located in a store in which said products may be acquired by said customer. (Col 9, lines 18-23)

Claim 4: Suzuki discloses a method as set forth in claim 1 wherein said product information is represented by machine readable coded indicia, said machine readable coded indicia being placed proximate to said selected product, said entering being accomplished by scanning said machine readable coded indicia by said customer processing device (Col 9, lines 18-23). A more detailed description of the cited hand-held terminal can be found in Ogasawara (U.S. Patent Number: 6,386,450 Column 2, lines 31-46) and includes a portable scanner.

Claim 5: Suzuki discloses a method as set forth in claim 1 wherein said customer processing device is a wireless device. (Col. 9, lines 51-55)

Claim 10: Suzuki discloses a method as set forth in claim 1 wherein said selected discount is transmitted to a local server, said selected discount being saved in memory in said local server. (Col 9, lines 8-16)

Claim 11: Suzuki discloses a method as set forth in claim 1 wherein said selected discount is saved in a memory within said customer processing device. (Col 11, lines 42-49)

Claim 12: Suzuki discloses a method as set forth in claim 1 and further including: associating customer identification information with said selected discount in said memory. (Col 7, lines 7-35)

Claim 13: Suzuki discloses a method as set forth in claim 12 and further including: providing customer identifying information for identifying said customer at a checkout terminal; and retrieving said selected product information and said selected discount

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associated with said customer in response to receiving said customer identifying information at said checkout terminal. (Col 7, line 58 through Col 8, line 14)

Claim 14: Suzuki discloses a method as set forth in claim 13 and further including deducting an amount representative of said selected discount from charges otherwise applicable for said selected product at said checkout terminal. (Col 8, lines 15 - 29)

Claim 15: Suzuki discloses a method as set forth in claim 14 and further including updating databases associated with said selected product, said updating being initiated at said checkout terminal. (Col 8, lines 2-29)

Claim 16: Suzuki discloses a method as set forth in claim 1 wherein said products are offered for sale to said customers. (Col 6, lines 31-52)

Claims 17 and 18: Suzuki discloses method as set forth in claim 1. While Suzuki is silent with regard to offering products for lease or license, it is old and well known that chain stores issue fishing and hunting licenses as well as offer products for lease such as carpet cleaners (Col 5, lines 62 – 65 and Col 6, lines 15-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include all available store products and services in invention disclosed by Suzuki. One would have been motivated to include all products and services, including licenses and leases, in order to allow the store to track customer purchasing decisions and target promotions to its customers (Col 6, lines 1 – 14).

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8. Claims 19, 21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over A. Asthana, M. Cravatts and P. Krzyzanouski, (An indoor wireless system for personalized shopping assistance, in: eds. L.-F. Cabrera and M. Sattyanarayanan, *Workshop on Mobile Computing Systems and Applications* (IEEE Computer Society Press, December 1994) pp. 69–74) in view of Suzuki (U.S. Patent Number 6,129,274).

Claim 19: Asthana et al. discloses a customer processing device comprising:

- a. Means arranged for entering product information into said customer processing device, said product information being sufficient to identify a selected product. (Col 1, paragraph 2)
- b. Means for transmitting said product information from said customer processing device to a server, said server being responsive to a receipt of said product information for determining discount information, said discount information being related to a plurality of different discounts available from one or more different entities for said selected product. (Col 8, paragraphs 1 – 4)
- c. Means for receiving said discount information from said server to said customer processing device. (Col 8, paragraphs 1 – 4).
- d. Means for displaying said discount information on a display screen of said customer processing device. (Column 9, paragraph 1 through column 10, paragraph 2)

- e. Input means for enabling said customer to choose a selected discount from said plurality of different discounts. (Column 9, paragraph 1 through column 10, paragraph 2)
- f. While Asthana is silent with regard saving said selected discount in a memory and retrieving the discount from memory upon checkout. The analogous teachings of Suzuki disclose reading transaction information from history and totaling the final purchase price upon checkout (Suzuki: Col 7, line 58 through Col 8, line 14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a history of items the users has selected for purchase, and there associated discounts, and then using said history in order to facilitate the checkout process. One would have been motivated to include such a feature in order to speed up the checkout process and thereby providing a benefit to both the customer and the retail establishment.

While both Asthana and Suzuki are both silent with regard to charging an appropriate account for each selected discount chosen by said customer, said charge being made after said customer has paid for said selected product. It is obvious that redeemed discounts must be accounted for in some fashion. This accounting usually includes either write-offs or manufacturer reimbursements. Suzuki discloses both a loyalty incentive account and a senior citizen discount account

that can be used for discount processing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ability to charge appropriate accounts after the discount has been chosen and the product paid for. One would have been motivated to do this in order to allow the retail store to properly account for the discounts it provides. (Suzuki: Col 7, lines 7 – 35)

Claim 21: Asthana et al discloses the customer processing device as set forth in claim 19 wherein said means for transmitting is further selectively operable to transmit information related to said user selection to server system. (Col 9, lines 8-13 and Col 5, lines 17-19)

Claim 28: Suzuki discloses a programmed product, said programmed product being executable by a computer system to generate program signals effective for processing discounts to customers for products being offered to said customers said program signals being selectively operable for:

- a. Enabling an entering of product information into a customer processing device, said product information being sufficient to identify a selected product. (Col 1, paragraph 2)
- b. Enabling a transmission of said product information from said customer processing device to a server, said server being responsive to a receipt of said product information for determining discount

information, said discount information being related to a plurality of different discounts available from one or more different entities for said selected product, said server being operable for transmitting said discount information from said server to said customer processing device. (Col 8, paragraphs 1 – 4)

- c. Effecting a display of said discount information on a display screen of said customer processing device. (Column 9, paragraph 1 through column 10, paragraph 2)
- d. Enabling user input to said customer processing device whereby said user is enabled to choose a selected discount from said plurality of different discounts. (Column 9, paragraph 1 through column 10, paragraph 2)
- e. While Asthana is silent with regard to enabling a determination of a request for checkout processing when said customer requests to pay for said selected product, said program signals being further operable for enabling a retrieval of said selected discount from memory upon said determination. The analogous teachings of Suzuki disclose reading transaction information from history and totaling the final purchase price upon checkout (Suzuki: Col 7, line 58 through Col 8, line 14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a history of items the

users has selected for purchase, and there associated discounts, and then using said history in order to facilitate the checkout process. One would have been motivated to include such a feature in order to speed up the checkout process and thereby providing a benefit to both the customer and the retail establishment.

- f. While both Asthana and Suzuki are both silent with regard to charging an appropriate account for each selected discount chosen by said customer, said charge being made after said customer has paid for said selected product. It is obvious that redeemed discounts must be accounted for in some fashion. This accounting usually includes either write-offs or manufacturer reimbursements. Suzuki discloses both a loyalty incentive account and a senior citizen discount account that can be used for discount processing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ability to charge appropriate accounts after the discount has been chosen and the product paid for. One would have been motivated to do this in order to allow the retail store to properly account for the discounts it provides. (Suzuki: Col 7, lines 7 – 35)

9. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent Number 6,129,274) in view of Fajkowski (U.S. Patent Number: 5,905,246).

Claim 30: Suzuki discloses a computer system arranged for processing discounts to customers for products being offered to said customers discount processing system as in claim 29, but does not specifically refer to the necessary component of storing the data in a format that provides a means for assigning charges to appropriate store and manufacturer accounts for the proper allocation of said preferred discount.

However, Fajkowski discloses a similar apparatus for coupon management and redemption that specifically includes a redemption report developed from data stored on a server that is used to assign charges to proper store and manufacturer accounts for the proper allocation of said preferred discount (Col 22, lines 11-23). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such functionality in the computer system described in Suzuki, so as to obtain manufacturer reimbursements and other accounting functions necessary upon coupon redemption.

Response to Arguments

10. Applicant's arguments with respect to claims 1 – 5, 10 – 19, 21, 24, and 26 – 30 have been considered but are moot in view of the new ground(s) of rejection.

However, the examiner would like to point out that Suzuki does disclose that consumers are displayed a plurality of different discounts such as discounts based on scanned products, discounts based on shopping history, discounts based on age, discounts based on current store promotions, and discounts based on loyalty points (Col 4, line 37 through Col 5, line 18 and Col 7, lines 7 – 57). Additionally, Asthana

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discloses offering a plurality of discounts to shoppers as well (Col 8, paragraphs 1 – 4 and Col 9, paragraph 3 through Col 10, paragraph 2). Both Suzuki and Asthana incorporate customer input and interaction with regard to promotional products. (See relevant sections disclosed in the office action for examples.)

In response to the applicant's arguments that there is no suggestion or nexus among the references to even suggest any combination of those references, the examiner suggests the applicant read the motivational statement present in each combination. The references are very similar in both the location in which they are used, the art in which they are relevant, and the customer issues in which they address. Given these similarities and the motivation provided in the office action it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the references cited.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

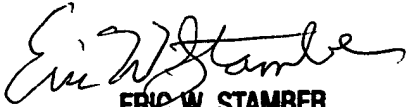
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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